UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,858	09/30/2003	Masahiro Minowa	9319H-000561	4622

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/675,858	MINOWA, MASAHIRO
	Examiner	Art Unit	
	Neil R. McLean	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 September 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-17</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-17</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>30 September 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09/30/2003; 1/19/2005</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Priority

1.   Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d).

Priority Number 2002-298995   10/11/2002   Japan

Priority Number 2002-298994   10/11/2002   Japan

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   Claims 11 and 17 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

In claim 17, a "program" is being recited; however, computer program would

reasonably be interpreted by one of ordinary skill in the art as software, per se.   This

subject matter is not limited to that which falls within a statutory category of invention

because it is limited to a process, machine, manufacture, or a composition of matter.

Software is a function descriptive material and a function descriptive material is non-

statutory subject matter.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable by

Goring (US 2002/0077892) in view of Warmus et al. (US 6,446,100).

Regarding Claim 1:

        (i)   Goring teaches a method of controlling a printing apparatus which prints

payment transaction print data ("**printing a receipt** which includes a printed image"; [0009],

lines 1-2) generated on a basis of input information concerning merchandise sales

("downloading transaction information"; [0009], lines 2-3) with addition of predetermined image

data ("retrieving an image **associated with** the transaction information"; [0009], lines 3-4), said

method comprising the steps of:

        obtaining the payment transaction print data ("the kiosk 300 .....and receives the receipt

details". [0018], lines 1-6);

retrieving a predetermined character string ("**preassigned** location";[0018], lines 10-12) indicative of a print position of the image data to be printed from the payment transaction print data;

obtaining a location specified by the retrieved predetermined character string ("the system may be configured to require that the service provider **specifies** the graphic and its **location** (e.g. header, footer, margin, specific box, etc.). This could be done for redundancy purposes (in which case the kiosk 300 could either print the graphic based on the **stored information** or based on the **received information** depending on the design choice") [0018], lines 14-22);

adding the image data to the payment transaction print data (FIG. 2 illustrates a coupon/receipt printed with a fixed graphic) based on the obtained location ("the coupon is **incorporated** with the physical receipt"; [0019]) so as to print the image data with a position specified by location serving as a reference ([0018], lines 6-9), thereby obtaining a synthesized print result.

(ii)   However, Goring does not disclose expressly the use of line number(s) when referencing the obtained location. Goring states that "the system may be configured to require that the service provider specifies the graphic and its location (e.g. header, footer, margin, specific box, etc."

(iii)   Warmus et al. teaches an apparatus and method for controlling a display device such as an electronic press that permits the display of fixed and variable information.

Warmus et al. also teaches that a user may select an area of a page for reproduction of variable information therein, at which point a line object, a text object or an image object may be selected (Column 9, lines 25-28).

Warmus et al. then discloses using the cursor position to define where a line object, text object or and image object is to be inserted (Column 9, lines 28-40).

(iv)   Warmus et al. and Goring are combinable because they are from the same field of endeavor.

(v)   At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have included a line number as a means to determine the placement of text and images.

(vi)   The suggestion/motivation for doing so would have been to use the cursor as a means to define the location of object placement. A printing system which has the ability to produce customized information, wherein a customized image is merged with other standardized information and printed or displayed is a desirable feature when producing any kind of document. This will allow the user to determine the exact appearance of a document.

(vii)   Therefore, it would have been obvious to combine the variable imaging system for and electronic press as taught by Warmus et al. with the system and method for configuring graphical coupons and receipts as taught by Goring to obtain the invention as specified.

Regarding Claim 2:

Goring teaches a method according to claim 1, further comprising the steps of:

generating an image addition setting command based on the obtained location

("the kiosk 300 could either print the graphic **based** on the stored information or **based** on the received

information"; [0020]); and

transmitting the payment transaction print data and the image addition setting

command to the printing apparatus ([0022]);

wherein the printing apparatus **adds** the image data to the payment transaction

print data based on a result of analysis of the image addition setting command ("the

coupon is **incorporated** with the physical receipt"; [0019]).

Regarding Claim 3:

Goring teaches a method according to claim 2, wherein the predetermined

character string is a start character string indicative of a position to start addition of the

image data ("the system may be configured to require that the service provider specifies the image 600

and its location"; [0020]); and

wherein, in the step of obtaining the location, a location specified by the start

character string is obtained ([0018], lines 14-22).

Regarding Claim 4:

Goring teaches a method according to claim 2, wherein the predetermined

character string is made up of a start character string indicative of a **position to start**

addition of the image data, and an end character string indicative of **a position to end**

addition of the image data ("kiosk 300 receives the Raw data (including character data and printer

control codes) and prints the image 900 (FIG. 3) **in the location indicated** by the received Raw data"

[0021]);

wherein, in the step of obtaining the location, a plurality of location to be

specified by the start character string and by the end character string are obtained

("Since there may be **no limitation** on the placement of the image the location is included with the Raw

data." [0021]).

Regarding Claim 5:

Goring teaches a method according to claim 4, wherein the printing apparatus

has stored therein a plurality of image data files which are files of the image data ("A

content provider may develop image information and store it in a file (e.g. a bit-mapped image file, a Joint

Photographic Experts Group ("JPEG") file, Tagged Image File Format ("TIFF") file, or any other image

file" [0014]). the method further comprising the steps of:

storing (See Image Database 200 in Figure 1) a definition table("Other storage

structures may be employed, such as a linking **table**") in which the start character string and the

end character string are correlated with image designation data for designating an

image data file out of a plurality of image data files stored in the printing apparatus

("Once the image information is stored, either **locally** or through a Universal Resource Locator (URL)

also known as an Internet address, an image database 200 may be established"; and

obtaining, from the definition table, image designation data which are related to the extracted start character string and the end character string, wherein, in the step of generating the image addition setting command, the image addition setting command is generated on the basis of the obtained location and the image designation data ("Kiosk 300 may communicate with database 200 and thus download images which are linked to the supported services" [0017]).

Regarding Claim 6:

Goring teaches a method according to claim 4, further comprising the step of setting at least one of the start character string and the end character string ("kiosk 300 receives the Raw data (including character data and printer control codes) and prints the image 900 (FIG. 3) **in the location indicated** by the received Raw data" [0021]).

Regarding Claim 7:

Goring teaches a method according to claim 6, further comprising the step of setting image designation data in which the image designation data are set in correlation with at least one of the start character string and the end character string to be set in the step of setting the character string ("the system may be configured to require that the service provider **specifies** the graphic and its **location** (e.g. header, footer, margin, specific box, etc.). This could be done for redundancy purposes (in which case the kiosk 300 could e ither print the graphic based on the **stored information** or based on the **received information** depending on the design choice") [0018], lines 14-22);

Regarding Claim 8:

Goring teaches a method according to claim 4, further comprising the step of setting the location in which, in the step of obtaining the location, setting is made as to which is obtained between the location in the start character string and the location which is one line below the start character string, and setting is made as to which is obtained between the location in the end character string and the location which is one line above the end character string ("the system may be configured to require that the service provider **specifies** the graphic and its **location** (e.g. header, footer, margin, specific box, etc.). This could be done for redundancy purposes (in which case the kiosk 300 could either print the graphic based on the **stored information** or based on the **received information** depending on the design choice") [0018], lines 14-22);

Regarding Claims 9 and 14:

(i)   Goring teaches a system and method for configuring and printing graphical coupons and/or receipts, however, Goring fails to teach a method of printing which includes a color printer.

(ii)   Warmus et al. teaches an apparatus and method for controlling a display device permitting the display of fixed and variable information. A control unit 52, which may be implemented by a personal computer or another type of computer, includes a memory 53 and stores therein data representing images to be printed. The variable information may be stored in a database (See Figure 3).

The control unit 52 may operate a fax machine 64 and/or may communicate with other remote devices to send properly converted combined files, as desired (Column 6, lines 23-25).

The control unit 52 is further responsive to control and make ready files and causes one or more demand printing systems 62 to print desired pages (Column 6, lines 17-19).

Warmus et al. further discloses the use of **color printers** (Column 6, lines 62-67) to perform the above mentioned.

(iii)   Warmus et al. and Goring are combinable because they are from the same field of endeavor.

(iv)   The suggestion/motivation for doing so would be to enhance the clarity and display of the text and images. Some customers may prefer to see ads in color and colors may compel people to read ads and take note of the advertisement.

(v)   Therefore it would have been obvious for one of ordinary skill in the art to have incorporated the color printer of Warmus et al. with the POS system and method for configuring and printing graphical coupons and receipts as taught by Goring.

Regarding Claim 10:

(i) Goring teaches a method of generating receipt print data ("printing a receipt which includes a printed image"; [0009], lines 1-2) by adding stored image data to payment

transaction print data generated by a host computer based on input information

concerning merchandise sales, the method comprising the steps of:

storing the image data (see Database 200 in Figure 1);

obtaining the payment transaction print data ("the kiosk 300 processes the financial

transaction, sends the results to the service provider and receives the receipt details". [0018], lines 1-

6) from the host computer (100 in Figure 1);

obtaining from the host computer an image addition setting command for printing

with the image data being added ("the kiosk 300 could either print the graphic based on the stored

information or based on the received information"; [0020];

analyzing the image addition setting command to thereby obtain a line number

indicative of a print position of the image data ("the kiosk 300 could either print the

graphic based on the stored information or based on the received information"; [0020]; and

generating the receipt print data for printing with the image data being added to the

payment transaction print data based on the location ("the coupon is incorporated with the

physical receipt"; [0019]).

(ii)   However, Goring does not disclose expressly the use of line number(s)

when referencing the obtained location. Goring states that "the system may be

configured to require that the service provider specifies the graphic and its location (e.g.

header, footer, margin, specific box, etc."

(iii)   Warmus et al. teaches an apparatus and method for controlling a display

device such as an electronic press that permits the display of fixed and variable

information.

Warmus et al. also teaches that a user may select an area of a page for reproduction of variable information therein, at which point a line object, a text object or an image object may be selected (Column 9, lines 25-28).

Warmus et al. then discloses using the cursor position to define where a line object, text object or and image object is to be inserted (Column 9, lines 28-40).

(iv)   Warmus et al. and Goring are combinable because they are from the same field of endeavor.

(v)   At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have included a line number as a means to determine the placement of text and images.

(vi)   The suggestion/motivation for doing so would have been to use the cursor as a means to define the location of object placement. A printing system which has the ability to produce customized information, wherein a customized image is merged with other standardized information and printed or displayed is a desirable feature when producing any kind of document. This will allow the user to determine the exact appearance of a document.

(vii)   Therefore, it would have been obvious to combine the variable imaging system for and electronic press as taught by Warmus et al. with the system and method for configuring graphical coupons and receipts as taught by Goring to obtain the invention as specified.

Regarding Claim 11:

Goring teaches a program for executing the steps of the method of controlling a printing apparatus according to claim 1 (The program code or device which performs the function described in [0027].

Regarding Claim 12:

Goring teaches a printer driver for enabling a computer to execute the steps of the method of controlling a printing apparatus according to claim 1.

Note: A device driver is an **inherent feature** that allows a computer to control printers, displays, disk drives, CD-ROM readers and so on in order to convert the more general input/output instructions of the operating system to messages that the device type can understand.

Regarding Claim 13:

(i)   Goring teaches a printing apparatus to generate receipt print data ("printing a receipt"; [0009], lines 1-2) by adding image data ("which includes a printed image"; [0009], lines 1-2) to payment transaction print data ("the kiosk 300 .....and receives the receipt details". [0018], lines 1-6) generated by a host computer based on input information concerning merchandise sales, the printing apparatus comprising:

means for storing the image data (The program code or device which performs the function described in [0017];

means for obtaining the payment transaction print data from the host computer

data (The program code or device which performs the function described in [0018],

lines 1-6);

means for obtaining from the host computer an image addition setting command

for printing with the image data being added (The program code or device which

performs the function described in [0020]);

means for analyzing the image addition setting command to thereby obtain a

location indicative of a print position of the image data (The program code or device

which performs the function described in [0020]); and

means for generating the receipt print data by adding the image data to the

payment transaction print data based on the location (The program code or device

which performs the function described in [0019].

(ii)   However, Goring does not disclose expressly the use of line number(s)

when referencing the obtained location. Goring states that "the system may be

configured to require that the service provider specifies the graphic and its location (e.g.

header, footer, margin, specific box, etc."

(iii)   Warmus et al. teaches an apparatus and method for controlling a display

device such as an electronic press that permits the display of fixed and variable

information.

Warmus et al. also teaches that a user may select an area of a page for

reproduction of variable information therein, at which point a line object, a text object or

an image object may be selected (Column 9, lines 25-28).

Warmus et al. then discloses using the cursor position to define where a line object, text object or and image object is to be inserted (Column 9, lines 28-40).

(iv)   Warmus et al. and Goring are combinable because they are from the same field of endeavor.

(v)   At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have included a line number as a means to determine the placement of text and images.

(vi)   The suggestion/motivation for doing so would have been to use the cursor as a means to define the location of object placement. A printing system which has the ability to produce customized information, wherein a customized image is merged with other standardized information and printed or displayed is a desirable feature when producing any kind of document. This will allow the user to determine the exact appearance of a document.

(vii)   Therefore, it would have been obvious to combine the variable imaging system for and electronic press as taught by Warmus et al. with the system and method for configuring graphical coupons and receipts as taught by Goring to obtain the invention as specified.

Regarding Claim 15:

Goring teaches a merchandise sales data processing apparatus having the printing apparatus according to Claim 13; and

a host computer which controls the printing apparatus ("the kiosk 300 may be

replaced by a Point-Of-Sale (POS) terminal" [0026]) by transmitting the payment transaction

print data and the image addition setting command to the printing apparatus, wherein

the host computer comprises:

means for generating the payment transaction print data ("the POS terminal

processes the transaction" [0026]

means for retrieving a predetermined character string indicative of a print

position of the image data to be printed from the payment transaction print data string

(The program code or device which performs the function described in [0018]);

means for obtaining the location specified by the extracted predetermined

character string (The program code or device which performs the function described in

[0018]);

means for generating the image addition setting command based on the

obtained location (The program code or device which performs the function described in

[0020]); and

means for transmitting the payment transaction print data and the image addition

setting command to the printing apparatus (The program code or device which performs

the function described in [0018].

Regarding Claim 16:

Goring teaches a POS system comprising:

the merchandise sales data processing apparatus according to claim 15; and

a POS server ([0026], lines 1) for managing the merchandise sales data

processing apparatus, the POS server being connected to the merchandise sales data

processing apparatus through a network (service provider described in [0026].

Regarding Claim 17:

A program the steps of the method of generating receipt print data according to

claim 10 (The program code or device which performs the function described in [0009]);

Conclusion

1.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Parks et al. (US 5,025,396) teaches a method of merging an

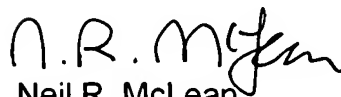alphanumeric data stream with a digitized image file.

Any inquiry concerning this communication or earlier communications from the

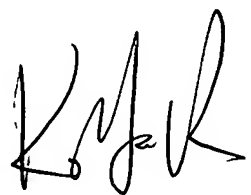examiner should be directed to Neil R. McLean whose telephone number is 571.

270.1679. The examiner can normally be reached on Monday through Friday   7:30AM-

5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, King Poon can be reached on 571.272.7440. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. McLean
07/27/2007

KING Y. POON
~~PRIMARY~~ EXAMINER
Supervising Patent